

REMARKS

Claims 1-9 are pending in the present application. Claims 10-44 are withdrawn subject to a restriction requirement. In the office action of June 2, 2006, the following actions were taken:

- (1) Claims 1-9 were rejected under 35 U.S.C. 112, second paragraph;
- (2) Claims 1-4 and 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,632,584 (hereinafter "Morgan"); and
- (3) Claims 1-3 and 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,514,677 (hereinafter "Ramsden").

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 1-9 under 35 U.S.C. 112, second paragraph. Specifically, the Examiner has asserted that the terms "in thermal contact" and "overprinted" are indefinite. There are two definitions in the specification that will add clarity to this issue for the Examiner. Before reciting these definitions, it is pointed out that it is well established that the Applicant can be its own lexicographer. With this in mind, here are the definitions:

As used herein, "thermal contact" refers to the spatial relationship between an absorber and a color forming composition. For example, when an absorber is heated by interaction with infrared radiation, the heat generated by the absorber should be sufficient to cause the leuco dye of the color forming composition to darken, or change or become colored, through a chemical reaction. Thermal contact can include close proximity between an absorber and a color forming composition, which allows for heat transfer from the absorber toward the leuco dye and/or activator. Thermal contact can also

include actual contact between an absorber and leuco dye, such as in immediately adjacent layers, or in an admixture including both constituents.

As used herein, “optical proximity” refers to the spatial relationship of the stabilizer with respect to the infrared absorber. Specifically, in order for the stabilizer to effectively protect the infrared absorber from significant decrease in activity, the stabilizer can be admixed with or overcoated with respect to the infrared absorber.

Thus, it is clear from the specification that the term “thermal contact” includes both admixtures and layers. Further, there is nothing in the specification that would suggest that the color-forming composition cannot be a layered composition. Further, claim 1 requires that the “stabilizer is admixed with or overprinted” with respect to the infrared absorber, which is also carefully set forth and explained in the specification. Thus, one skilled in the art, viewing the entire specification as a whole, would understand the meaning of these claim terms, as they were deliberately chosen and are fully consistent with the teachings of the specification. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 103

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. Further, the Examiner has to establish some motivation or suggestion to combine and/or modify the references, where the motivation must arise from the references themselves, or the knowledge generally available to one of ordinary skill in the art. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The Examiner has rejected claims 1-4 and 7-9 as being obvious. Specifically, claims 1-4 and 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over

Morgan, and claims 1-3 and 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ramsden.

The Morgan Reference

Morgan sets forth a laser-imageable printing system for wet lithographic printing. The composition is modifiable using laser energy, i.e. between hydrophobic and hydrophilic in order to form wet "negatives." A specific chroman is listed amongst many possible components that can act as a reducing agent for silver ions. See col. 8, lines 37-39.

The Ramsden Reference

Ramsden discloses a thermally developable infrared sensitive imaging material which contains heat-bleachable antihalation compositions. The infrared absorbing compound described in Ramsden can include a moiety of chroman-2,4-dione, attached to the infrared sensitive imaging material, amongst a list of many other possible attached moieties.

The Currently Pending Claims

Claim 1 is no longer inclusive of the presence a chroman composition, as the claim has been narrowed to state that the stabilizer is a thiolane-nickel complex, a spiroindane, or a mixture thereof. Thus, if chroman is present, it can only be present in addition to one or both of these stabilizers. As the prior art relies upon various teachings regarding chromans, the rejection of claims 1, 2, and 4-9 have been rendered moot. Allowance of these claims is respectfully requested.

New claims 45 and 52 have been added to claim the subject matter cancelled from claim, namely the use of chroman as a stabilizer without the requirement of the presence of other listed stabilizers. This particular embodiment has been narrowed in two ways. First, claim 3 has been incorporated into claim 1 and is represented as new claim 45. Further, claim 52 has been amended to require that when chroman is present as the stabilizer for the infrared absorber, another component must also be present for providing anti-oxidative properties to the leuco dye.

Regarding claim 45, Morgan does not teach of the presence of a chroman in a composition that provides the dual function of both stabilizing the infrared absorber

and inhibiting oxidation of the leuco dye. In Morgan, the presence of chroman (among many other possible compound candidates) is used as a reducing agent for silver ions that are present in the disclosed system. If the chroman composition is used as a reducing agent for silver ions (which must be present in Morgan), then it cannot maintain an appropriate state to function as claimed in claim 45. In other words, the chroman composition would not be present in the composition so that it could both stabilizing the infrared absorber and inhibiting oxidation of the leuco dye, due to the presence of silver ions with will cause the chroman to oxidize. Further, in claim 52, there is no teaching or suggestion of the presence of a separate compound that is used in addition to the chroman stabilizer that acts as an anti-oxidant for the leuco dye. Thus, claims 45 to 58 are believed to be allowable over Morgan.

Reconsideration of the rejections over Morgan is respectfully requested on these grounds.

Regarding Ramsden, the discussion of the presence of a chroman moiety occurs in conjunction with a side group present attached to an infrared radiation absorbing compound. In other words, the chroman moiety is not separate and distinct from the infrared radiation absorbing compound. In both claims 45 and 52, the claim elements clearly states that the chroman stabilizer is admixed with or overprinted with respect to the infrared absorber. Thus, this claim does not read on Ramsden, nor does Ramsden teach or suggest a modification of its teachings to arrive at the claimed invention. Reconsideration on these grounds is respectfully requested.

In view of the foregoing, Applicants believe that claims 1, 2, 4-9, and 45-58 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 29th day of August, 2006.

Respectfully submitted,



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